

REMARKS

Claims 18-34 are pending in this application; claims 1-17 have been canceled without prejudice. New claims 18-34 are system, not method claims, but have essentially the same limitations as original claims 1-17. Consequently, a new prior art search by the Patent Office is not believed necessary.

The Office Action objects to the specification as referring to Figures 1, 2a, and 2b “but only Figure 1 was submitted.” Applicant respectfully submits that the published version of the present application (pub. no. 2002/0178442) contains Figures 2a and 2b. In any event, Applicant has enclosed herewith another copy of the formal drawing sheet showing Figures 2a and 2b. No new matter has been added.

Claims 1-17 have been rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. This rejection is respectfully traversed as moot. Claims 1-17 have been canceled, and corresponding new claims 18-34 are computer system claims (and thus is clearly “in the technological arts”).

Claims 1-17 were rejected in the Office Action under 35 U.S.C. § 103 as unpatentable over U.S. Patent No. 5,861,881, to Freeman et al. This rejection is respectfully traversed for the following reasons.

First, Applicant respectfully notes that 17 claims were pending, but the Office Action only addresses the limitations of claims 1 and 17. No substantive grounds are provided to support the rejection of dependent claims 2-16 over Freeman. A fundamental doctrine of patent law is that prior art rendering an independent claim unpatentable does not, without more, render claims depending from that independent claim unpatentable. A separate analysis must be performed for each dependent claim. Clearly, without such an analysis, the Office Action has not presented a *prima facie* case of obviousness for any of dependent claims 2-16. That is, the Office Action provides no grounds whatsoever for rejecting claims 2-16.

Next, Applicant respectfully submits that Freeman is not analogous art, much less a proper § 103 reference. Freeman is directed to a method of providing an “interactive” experience to a viewer, but that method does not involve two-way communication. Instead, multiple video streams are provided downstream to a display device. When a viewer provides input (for

example, by answering a multiple choice question) to the local display device, the display device switches from one video stream to another, thus “fooling” the viewer into thinking that the originator of the video signal has received and reacted to the viewer’s input. See, for example, Freeman, column 5, lines 55-67 and column 6, lines 1-2, discussing the trigger points and branching utilized by the claimed system. The trigger points are the places in the parallel signals at which switching is appropriate, and the branching relates to how the video data is viewed by a viewer.

Thus, it should be clear to the Patent Office that Freeman teaches only one-way communication, and is therefore non-analogous art to the present invention

For the same reasons, Freeman cannot render the claimed invention unpatentable. Put very simply: Freeman does not disclose eliciting feedback, a key limitation of claim 1 (and of new claims 18-34).

Finally, to support the § 103 rejection the Office Action takes official notice of a number of other claim 1 and claim 17 limitations missing from Freeman. Pursuant to MPEP § 2144.03(C), Applicant hereby traverses each such taking of official notice and respectfully demands that the Patent Office provide supporting documentary evidence in the next office action if the corresponding rejections are to be maintained.

As best understood, the first taking of official notice asserts that “it is old and well known for any person to use a known method or process.” Applicant does not dispute this assertion, to the extent understood, but questions whether it is relevant and supports the rejection of claim 1.

The next taking of official notice appears to assert that “it would have been obvious to a person of ordinary skill at the art at the time of Applicant’s invention to have included the producer or director of the show to receive the audience queries and feedback because such a modification would allow for better production of the show.” This taking of official notice is both improper as a factual matter (Freeman does not disclose feedback, and thus cannot be modified as suggested) and as a legal matter (it improperly uses Applicant’s disclosure as a motivation (roadmap) for taking official notice). Had Applicant not described the advantages of providing queries and receiving feedback, the Patent Office would have had no reason to think that the asserted officially noticed advantage existed.

A third taking of official notice, as best understood, asserts:

[I]t is old and well known in marketing to advertise products related to a particular show or storyline. For example, toys/child products are advertised during cartoon/child programs. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included placing product advertisement within the storyline in order to better target the ads.

This taking of official notice is simply misplaced. Claim 17, for example, is not directed merely to placing a product advertisement within a show. A "prequel-mercial" is defined at page 27 of the substitute application:

Prequel-mercials are story driven commercials of 30-60 second duration that sell product and entice viewership. As part of launch, "prequel-mercials" can be used both for marketing the show and engaging future audience participation. Although primarily a story content vehicle, the expense of prequel-mercials can be subsidized by consumer item product placement. Also, this format can be used throughout the season for strategic storytelling and as a general advertising vehicle for show sponsors.

Thus, prequel-mercials are not merely targeted ads inserted into a show – they are ads for a show that also may include product placements. Further, at the query-feedback stage (the stage to which the claims are directed), the prequel-mercial may be placed in no show at all – it may be the only content provided to a test audience, and the sole means of testing audience interest in the show that is the subject of the prequel-mercial.

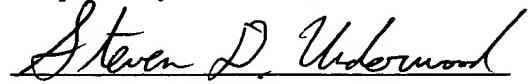
In light of the above, it should be clear to the Patent Office that the last taking of official notice is irrelevant to claim 17 (and related claims 28-34). A prequel-mercial is not suggested by a mundane product commercial in a TV show. Moreover, a toy commercial that airs during a cartoon may be targeted at children, but that doesn't make the toy commercial related to the storyline of the cartoon.

The Patent Office is respectfully reminded that any publications used to support the above-discussed takings of official notice should be proper prior art – an Internet printout, for example, dated later than January 2, 2001 clearly would be improper.

No fee is believed due in connection with this Response (other than the one-month extension fee authorized above). Should any other fee be required, please charge such fee to Deposit Account No. 50-0310.

Respectfully submitted,

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Enclosure (Figures 2a and 2b)